

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOSHIKI YANAGI

Appeal No. 2004-0071
Application No. 09/888,445

ON BRIEF

Before CAROFF, GARRIS, and MOORE, Administrative Patent Judges.
CAROFF, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 1. As acknowledged in appellant's reply brief, claim 2, the only other claim in appellant's application, stands withdrawn from consideration as being drawn to a non-elected invention and, thus, is not before us on appeal.

Claim 1, the sole claim on appeal, is directed to a porous sheet substrate from which pieces are to be cut or removed. In order to facilitate later removal of the pieces from the

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substrate, cut and non-cut portions are formed in the substrate along outlines defining the pieces.

The invention is more particularly described in claim 1 as follows:

1. A porous sheet substrate for cutting off porous sheet pieces, which comprises a polytetrafluoroethylene porous material or a composite sheet comprising the polytetrafluoroethylene porous material and a gas-permeable reinforcing member laminated on at least one side of the porous material, wherein cut portions and non-cut portions are formed along outlines of porous sheet pieces to be cut in a manner which permits the porous sheet pieces to be cut off against the non-cut portions by pushing the porous sheet pieces to be cut.

Claim 1 stands rejected for obviousness under 35 U.S.C. § 103 in view of admitted prior art (as described on page 1 of appellant's specification) taken with the following prior art reference:¹

Wilk	5,322,521	Jun. 21, 1994
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We have carefully evaluated the entire record on appeal in light of the opposing positions taken by the appellant and the examiner. Having done so, we conclude that the admitted prior art taken with Wilk supports a prima facie case of obviousness. Accordingly, we shall affirm the examiner's rejection.

¹A previously applied rejection under 35 U.S.C. § 112, second paragraph, is not mentioned in the examiner's answer and, thus, presumably has been withdrawn by the examiner on appeal.

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As explained by the examiner, appellant's specification describes the prior art as encompassing, inter alia, a porous sheet substrate composed of polytetrafluoroethylene (PTFE) from which pieces are to be cut using a punching machine.

Wilk shows a technique for removing pieces of material from a PTFE substrate by providing perforations (cut and non-cut portions) along the outlines defining the pieces of material to be later sheared from the substrate.

The primary issue in this appeal is whether Wilk is analogous art, viz., whether the teachings of Wilk are reasonably pertinent or applicable to the particular problem with which the appellant was concerned. We answer this question in the affirmative.

There is no question that, in determining whether a reference is applicable to an appellant's claims for purposes of establishing obviousness, a two-fold analysis is made. First, one decides if the reference is within the field of the appellant's endeavor. If it is not, one next determines whether the reference is reasonably pertinent to the particular problem with which the appellant was concerned.

Here, we can agree with the appellant that Wilk is not within the field of appellant's endeavor for the reasons

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presented in the appellant's brief. However, this does not end our inquiry. In agreement with the examiner, we find that the teachings of Wilk are reasonably pertinent to the problem addressed by appellant's claimed invention. To wit, both the appellant and Wilk are concerned with facilitating the removal of pieces of material (PTFE) from a larger substrate of that material. In other words, in our opinion Wilk represents analogous art in the sense that it evidences that it is known to facilitate such removal by providing perforations (cut and non-cut portions) along the outlines defining the pieces in order to make it easier or more convenient to shear off the pieces from the substrate at some later time.

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For the foregoing reasons, the decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

MARC L. CAROFF)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
BRADLEY R. GARRIS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
JAMES T. MOORE)	
Administrative Patent Judge)	

MLC/hh

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